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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,935	12/12/2001	Raymond Gerard St. Louis	KCC-16,727	2923

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 09/22/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,935

Applicant(s)

LOUIS ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7, 16, 18, 19, 40 and 46-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 8-15, 17, 20-39 and 41-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6-7, 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of Group 1, the species of Figures 1, 3-4 and 8 in Paper No. 8 is acknowledged.
2. Claims 3-5, 7, 16, 18, 19, 40 and 46-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8.
3. The restriction and election requirements are deemed proper and made FINAL.

Specification

Drawings

4. The drawings filed 3-5-02 have been placed in the file but approval thereof is held in abeyance until the issues discussed infra have been resolved.
5. The drawings are objected to because Figure 4 is not consistent with the description thereof on page 6, i.e. partly in section. In Figure 3, should the lines from 54 and 56 be dashed to denote underlying structure? In Figure 12, roller 376 should be shown and roller 376 should be 372, see page 50, line 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Description

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

7. The use of the trademark LYCRA(R)(pages 21 and 33) and KRATON(R), ESTANE(R), PEBAX(R), HYTREL(R), AFFINITY(R)(all on page 33)has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be in all capital letters or with a symbol but not both.

8. The disclosure is objected to because of the following informalities: The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims are not commensurate, see MPEP 608.01(d) and 1302.01. On page 13, line 8, "17" should be --17B--. In Figure 12, where is 257? On page 50, line 7, "376"(first) should be --372--. Also, it is unclear whether a targeted elastic material having elastic zones of different elastic tension in a laminate require the laminate to be a stretch bonded laminate or not, see the definitions of "targeted elastic""regions" or "zones", "targeted elastic material" and "targeted

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elastic laminate" which don't require stretch bonding and the definitions of "low tension zone" and "high tension zone" which do require a stretch bonded laminate. The definitions can all be found in the definitions portion of the specification.

Appropriate correction is required.

Claim Objections

9. Claims 21-23 and 25-27 are objected to because of the following informalities: in these claims, "the length...garment" should be --a length...garment--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. Claims 1-2, 6, 8-15, 17, 20-39, and 41-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 1-2, and 13, it is unclear whether the claims require targeted elastic material in the side panels, i.e. some part but not necessarily both, or material in each panel. Note the language "the waist end edge" on the last two lines of claim 1 and claim 13 yet "each leg opening" in claim 2. This also applies to claims 14 and 17, i.e. is there material in at least two portions of the chassis?, and claim 38. For purposes of examination with regard to the prior art it will be assumed that material in both side panels or at least two portions is required.

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Claim Language Interpretation

11. For purposes of the prior art rejections the claim language “elastic” is defined as set forth at page 8, lines 10-12. “Garment”, “personal care garment” and “protective garment” are defined as set forth on page 16, lines 2-9. “In the vicinity of the garment openings”, “aligned with the garment opening or edge” and “abutting a garment opening or edge” are defined as set forth at page 16, lines 10-20. “Targeted elastic regions” “targeted elastic zones”, “targeted elastic material”, “targeted elastic laminate” are defined as set forth at page 9, lines 4 et seq, i.e. the elastic is made in the same process as is the elastic material or laminate made therefrom. See also page 1, last paragraph, page 4, lines 7-11, page 26, lines 19-22 and page 53, lines 8-14. “Low or lower tension zone”, “High or higher tension zone” and “spacer zone” are defined as set forth on page 10, line 19- page 11, line 3, page 11, lines 7-12 and 19-20 except due to the lack of clarity discussed supra such will not be required to include a stretch bonded manufacture. It is noted that since the claims are drawn to an apparatus, even if such limitation were required, the claims would be product by process claims, see MPEP 2113, i.e. the structure of the end product not the method determines patentability. It is noted that the terminology “absorbent composite structure”, and “side panels extending from...composite” have not been specifically defined by the Applicants and thus will be given their broadest customary interpretation, i.e. the dictionary definition, in light of the specification. As set forth on page 18, lines 3-9, and page 22, lines 11-12 of the specification, the absorbent composite is the cover, liner and absorbent where

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coextensive, the side panels may be separate pieces attached to the composite or integrally formed therewith, i.e. an extension of a component of the composite structure. Therefore, in light of the specification, and the dictionary definition of "composite", i.e. "made up of distinct components; compound", the terminology "absorbent composite" is defined as the absorbent and at least one other layer or component where coextensive and the "side panels extending therefrom" being where the absorbent and layer are no longer coextensive.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-2, 6, 8-15, 17, 20-39, and 41-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Gompel et al., EP '052.

Claims 1-2, 6, 14-15, 17, 20, and 38-39: See definitions and discussion, supra, Figures, abstract, col. 1, lines 3-5, 19-20, 27-30, 34-49, 55 et seq, col. 2, lines 10-14 and 42-43, col. 4, lines 14-16, 18-22, 33-39, col. 5, line 43- col. 6, line 51, col. 6, line 56-col. 7, line 54, col. 8, line 51-col. 9, line 24(and thereby col. 3, line 66-col. 4, line 11, col. 4, line 31-col. 5, line 37, col. 8, lines 7-39,

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col. 9, lines 27-52 of '464), and claims, i.e. the chassis is 2, the absorbent composite is 32 and at least 52, the side panels are at least portions 10 of element 20 which extend from the composite, the leg openings are 16, the waist opening is 12, the targeted elastic material or pieces are the stretchable portions of 10 and the tension zones are disclosed at col. 7, lines 16-31 and col. 5, line 43-col.7, line 15. For example, if the gradient is increases from the waist to the leg a highest zone is adjacent the leg, a second highest zone is adjacent the highest zone and aligned with the waist opening and a third highest zone is adjacent the second and so on and thereby, there is a high zone aligned with each leg opening, e.g. the first, a high tension zone aligned with the waist opening, e.g. the second, a low zone, e.g. the third zone, and a spacer or second low tension zone, e.g. the fourth zone or the zone adjacent the waist. It is noted that the claims do not require the high zones to be equal and only require a low zone to be lower than a high zone. The claims do not set forth how the zones, other than the spacer zone and the high zone aligned with the waist, are positioned with regard to the other zones. For a second example, if the zones are created by bands, e.g., see Figures 2 and 5, the areas between 14, 18 and 44 have no or lower elasticity or stretchability than those areas with such bands. Also see the gradients can be high-low-high. Therefore, the '052 reference teaches the claimed zones. As best understood of the instant specification, see discussion of the definitions supra and the manufacturing processes of Figures 9-12 and 16, at the very least the device is set forth at col. 7, lines 32-54, i.e. material or laminate made elastic in the thermal bonding process with 36, 48 which also makes 36, 48 elastic so is part of the single manufacturing process of making the zoned elastic material. With regard

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to claims 8-9, 20-31 and 41-43, see col. 9, lines 18-24 and col. 1, lines 27-30 (and thereby the dimensions set forth at col. 3, line 66-col. 4, line 11, col. 4, line 31-col. 5, line 37, col. 8, lines 7-39, col. 9, lines 27-52 of '464), i.e. the length ranges and filament shapes as claimed are taught by '052. With regard to claims 10, 12, 28-31 and 44-45, see col. 6, lines 13-51 of '052. With regard to claim 11, see col. 8, line 51-col. 9, line 10. With regard to claims 13, 37 and 38, see portions of '052 cited supra, e.g., Figures 2 and 5. With regard to claims 32-34 and 36 '052 teaches a device which functions as set forth in claims. In claim 35 Applicant claims the device being swimwear which capability or function the '052 reference does not explicitly teach. However, the Van Gompel patent teaches all the claimed structure. Therefore there is sufficient factual evidence for one to conclude that the properties and functions of such claimed structure would also be inherent in the same structure of the Van Gompel device. See MPEP 2112.01.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1-2, 6, 8-15, 17, 20-39, and 41-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19, 21, 50-59 of copending Application No. 09/855,188 in view of Van Gompel '052 and Bunnelle et al, '123. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed after the '188 application the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application, and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with both the leg and waist openings, a low tension zone and a spacer zone between the waist end edge and the high tension zone aligned with the waist opening which specific gradient is in a side panel, a single manufacturing process and first and second basis weights which are not required by the

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claims of the other application, and the instant claims do not require 2) the specifics of claims 2-19, 51, 56 and 59 of the other application. With regard to 1), see cited portions of Van Gompel *supra*. To employ the claimed tension gradient in the laminate and the laminate in the side panel as taught by Van Gompel and as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially an absorbent garment, i.e. don't want it to leak. Also see Bunnelle et al, col. 11, lines 3- 61, i.e. an elastic can be directly contacted with a substrate or can be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to the basis weights, see col. 6, lines 13-51 of '052. With regard to 2), the claims of the instant application are broader with regard to those claims of the other application, i.e. they claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the broader, see *In re Goodman*, *supra*. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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16. Claims 1-2, 6, 8-15, 17, 20-39, and 41-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 and 49-58 of copending Application No. 09/855,189 in view of Van Gompel and Bunnelle et al, '123. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed after the '189 application the one way In re Vogel test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. Note the definitions in the other application, i.e. "Disposable garment", "TEL" and "TEM", the definitions in the instant application and claim language in both applications. The instant claims include 1) the TEM being in the side panel so as to have the one high tension zone aligned with both the leg and waist openings, a low tension zone and a spacer zone between the waist end edge and the high tension zone aligned with the waist opening which specific gradient is in a side panel, a single manufacturing process, and a first and second polymer compositions which are not required by the claims of the other application and the instant claims do not require 2) the specifics of claims 2-17, 18-23, 50, 55 and 58 of the other application. With regard to 1), see cited portions of Van Gompel supra. To employ the claimed tension gradient in the laminate and the laminate in the side panel as taught by Van Gompel and as claimed in the instant application in the device as claimed in the other application claims would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would provide improved fit and the desirability of good fit in any garment to be worn and especially a absorbent garment, i.e. don't want it to leak.

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Also see Bunnelle et al, col. 11, lines 3- 61, i.e. an elastic can be directly contacted with a substrate or can be stored and attached to the substrate later, i.e. a single manufacturing process or a non single manufacturing process. Therefore to make the manufacturing process a single process, if not already, would be obvious to one of ordinary skill in the art in view of the recognition of the interchangeability as taught by Bunnelle et al. With regard to the composition see col. 6, lines 13-51 of '052. With regard to 2), the claims of the instant application are broader with regard to those claims of the other application, i.e. those claims claim more specific embodiments, and once the applicant receives a patent for a more specific embodiment he is not entitled to a patent for a broader or generic invention. This is because the specific anticipates the broader, see *In re Goodman*, supra.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Common Ownership

17. Claims 1-2, 6, 8-15, 17, 20-39, and 41-45 are directed to an invention not patentably distinct from claims 1-19, 21 and 50-59 and claims 1-24 and 49-58 of commonly assigned 09/855,188 and 09/855,189, respectively. Specifically, see the double patenting rejections supra in which the lack of patentable distinctness is discussed and which discussion also applies here.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

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Commonly assigned 09/855, 188 and 09/855,189, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78⁹ and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Coenen et al reference is cited to show a method of making. The Pomplun et al reference teaches how heat shrinkable material is made.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. M. Reichle whose telephone number is 703-308-2617. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

K.M. Reichle
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